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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,786	04/08/2004	Ralph E. Wesinger JR.	GRAPH-005CON	9325

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EXAMINER

TIMBLIN, ROBERT M

ART UNIT	PAPER NUMBER
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2167

MAIL DATE	DELIVERY MODE
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10/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,786

Applicant(s)

WESINGER ET AL.

Examiner

Robert M. Timblin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 9-16, and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

This Office Action corresponds to application 10/821,786 filed 4/8/2004.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/23/2007 has been entered.

Response to Amendment

Applicant amends the present claims 1 and 5 to correct minor informalities. These amendments have been acknowledged and entered.

Declaration under 37 C.F.R. 1.131

The affidavit filed on 7/23/2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the prior cited art references. The reasoning is provided in the following:

Formal Requirements of a Declaration

From MPEP § 715.04[R-2]:

The following parties may make an affidavit or declaration under 37 CFR § 1.131:

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(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

(C) **> If a petition under 37 CFR § 1.47 was granted or the application was accepted under 37 CFR § 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR § 1.47 applicant or the legal representative, where appropriate.< .

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR §§ 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR § 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. Further, where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient. However, the affidavit or declaration, even though signed by fewer than all the joint inventors, must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection. *In re Carlson*, 79 F.2d 900, 27 USPQ 400 (CCPA 1935).

An affidavit is a statement in writing made under oath before a notary public, magistrate, or officer authorized to administer oaths. See MPEP § 604 through § 604.06 for additional information regarding formal requirements of affidavits. 37 CFR § 1.68 permits a declaration to be used instead of an affidavit. The declaration must include an acknowledgment by the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. § 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all

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statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

From MPEP 602 (II):

U.S. Patent and Trademark Office personnel are authorized to accept a statutory declaration under 28 U.S.C. § 1746 filed in the U.S. Patent and Trademark Office in lieu of an "oath" or declaration under 35 U.S.C. § 25 and 37 CFR § 1.68, provided that the statutory declaration otherwise complies with the requirements of law. Section 1746 of Title 28 of the United States Code provides:

Whenever, under any law of the United States or under any rule, regulation, order, or requirement made pursuant to law, any matter is required to be supported, evidenced, established, or proved by sworn declaration, verification, certificate, statement, oath or affidavit, in writing of the person making the same (other than a deposition, or an oath of office, or an oath required to be taken before a specified official other than notary public), such matter may, with like force and effect, be supported, evidenced, established, or proved by the unsworn declaration, certificate, verification, or statement, in writing of such person which is subscribed by him, as true under penalty of perjury, and dated, in substantially the following form:

[1] If executed without the United States:

"I declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on (date).

(Signature)."

[2] If executed within the United States its territories, possessions, or commonwealths:

"I declare (or certify, verify, or state) under penalty of perjury that the foregoing is true and correct. Executed on (date).

(Signature)."

The submitted declaration fails to fulfill all of the formal requirements for submission of a declaration under 37 C.F.R. §1.131.

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■ All of the named inventors (Ralph Wesinger and Christopher Coley) need to sign the declaration.

■ The declarant must set forth what type of declaration he/she is making in the body of the declaration (not the Remarks).

■ The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

Nevertheless, in order to advance prosecution of the application, the examiner will now proceed to consider the merits of the declarations.

Allegation of FACTS

MPEP § 715.07 (I) states, *inter alia*,

The essential thing to be shown under 37 CFR § 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR § 1.131.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along

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with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR § 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

In the case of the instant declaration, the Applicants have alleged conclusions, not facts as is required under 37 C.F.R. § 1.131.

The declaration alleges that the claimed invention was reduced to practice prior to the earliest effective date of Dozier reference, a conclusion that has yet to be drawn based upon the submitted evidence.

A proper declaration is required to allege FACTS, which are fully supported by evidence.

The evidence submitted in support of the Applicant's declaration includes Exhibits 1 through 6.

■ One fact that could be alleged based upon Exhibit 1 is that Mr. Kennedy's discussion with "Skeeter" about opportunities with respect to the Internet took place prior to 12/21/1994. This FACT would be fully supported by the document.

This evidence, however, by itself, fails to support the conclusion alleged in the Applicants' declaration that the discussion was about the Internet Front Door concept as described in paragraphs 9 - 10 in the declaration, and that the claimed invention was reduced to practice prior to the earliest effective date of the Dozier reference.

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■ The only fact that could be alleged based upon Exhibit 2 is the mere existence of an image of a person swinging a gold club.

This evidence, however, by itself, fails to support the conclusion alleged in the Applicant's declaration that the *claimed invention* was reduced to practice prior to the earliest effective date of the Dozier reference.

■ One fact that could be alleged based upon Exhibits 3 - 4 is that Christopher Coley sent a domain registration email of golfusa.net on 05/09/1995 (exhibit 3 and accordingly received confirmation (exhibit 4) on 05/16/1995.

This evidence, however, by itself, fails to support the conclusion alleged in the Applicant's declaration that the *claimed invention* was reduced to practice prior to the earliest effective date of the Dozier reference.

■ Similarly, Exhibits 5 - 6 also fails to support the conclusion alleged in the Applicant's declaration that the *claimed invention* was reduced to practice prior to the earliest effective date of the Dozier reference, since Exhibits 5 - 6 merely presents log files that seem to show information regarding database/website access.

As such, the Applicants have failed to meet their burden under 37 C.F.R. § 1.131(b).

Nevertheless, in order to advance prosecution of the application, the examiner will proceed to consider the remaining merits of the declaration and supporting evidence that has been submitted.

Conception

From MPEP § 715.07 (III):

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR § 1.131). As discussed above, 37 CFR § 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

(A) reduction to practice of the invention prior to the effective date of the reference; or

(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or

(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

Diligence

From MPEP § 715.07(a):

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to

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allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See MPEP § 2138.06 for a detailed discussion of the diligence requirement for proving prior invention.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947).

As stated above, since the Applicant alleges an actual reduction to practice prior to the date of the applied reference, diligence is not an issue.

Reduction to Practice

Regarding reduction to practice, MPEP § 715.07 states:

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.

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From MPEP § 2138.05:

Reduction to practice may be an actual reduction or a constructive reduction to practice which occurs when a patent application on the claimed invention is filed. The filing of a patent application serves as conception and constructive reduction to practice of the subject matter described in the application. Thus the inventor need not provide evidence of either conception or actual reduction to practice when relying on the content of the patent application. *Hyatt v. Boone*, 146 F.3d 1348, 1352, 47 USPQ2d 1128, 1130 (Fed. Cir. 1998).

When a party to an interference seeks the benefit of an earlier-filed U.S. patent application, the earlier application must meet the requirements of 35 U.S.C. § 120 and 35 U.S.C. § 112, first paragraph for the subject matter of the count. The earlier application must meet the enablement requirement and must contain a written description of the subject matter of the interference count. *Hyatt v. Boone*, 146 F.3d 1348, 1352, 47 USPQ2d 1128, 1130 (Fed. Cir. 1998). Proof of a constructive reduction to practice requires sufficient disclosure under the "how to use" and "how to make" requirements of 35 U.S.C. § 112, first paragraph. *Kawai v. Metlesics*, 480 F.2d 880, 886, 178 USPQ 158, 163 (CCPA 1973) (A constructive reduction to practice is not proven unless the specification discloses a practical utility where one would not be obvious. Prior art which disclosed an anticonvulsant compound which differed from the claimed compound only in the absence of a -CH₂- group connecting two functional groups was not sufficient to establish utility of the claimed compound because the compounds were not so closely related that they could be presumed to have the same utility.). The purpose of the written description requirement is "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978). The written description must include all of the limitations of the interference count, or the applicant must show that any absent text is necessarily comprehended in the description provided and would have been so understood at the time the patent application was filed. Furthermore, the written description must be sufficient, when the entire specification is considered, such that the "necessary and only reasonable construction" that would be given it by a person

skilled in the art is one that clearly supports each positive limitation in the count. *Hyatt v. Boone*, 146 F.3d at 1354-55, 47 USPQ2d at 1130-1132 (Fed. Cir. 1998) (The claim could be read as describing subject matter other than that of the count and thus did not establish that the applicant was in possession of the invention of the count.). See also *Bigham v. Godtfredsen*, 857 F.2d 1415, 1417, 8 USPQ2d 1266, 1268 (Fed. Cir. 1988) ("[t]he generic term halogen comprehends a limited number of species, and ordinarily constitutes a sufficient written description of the common halogen species, except where the halogen species are patentably distinct).

"In an interference proceeding, a party seeking to establish an actual reduction to practice must satisfy a two-prong test: (1) the party constructed an embodiment or performed a process that met every element of the interference count, and (2) the embodiment or process operated for its intended purpose." *Eaton v. Evans*, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000).

The same evidence sufficient for a constructive reduction to practice may be insufficient to establish an actual reduction to practice, which requires a showing of the invention in a physical or tangible form that shows every element of the count. *Wetmore v. Quick*, 536 F.2d 937, 942, 190 USPQ 223, 227 (CCPA 1976). For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development.

If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985).

For additional cases pertaining to the requirements necessary to establish actual reduction to practice see *DSL Dynamic Sciences, Ltd. v. Union Switch & Signal, Inc.*, 928 F.2d 1122, 1126, 18 USPQ2d 1152, 1155 (Fed. Cir. 1991) ("events occurring after an alleged actual reduction to practice can call into question whether reduction to practice has in fact occurred"); *Corona v. Dovan*, 273 U.S. 692, 1928 C.D. 252 (1928) ("A process is reduced to practice when it is successfully performed. A machine is reduced to practice when it is assembled, adjusted and used. A manufacture [i.e., article of manufacture] is reduced to practice when it is completely manufactured. A composition of matter is reduced to practice when it is completely composed." 1928 C.D. at 262-263 (emphasis added).); *Fitzgerald v. Arbib*, 268 F.2d 763, 765-66, 122 USPQ 530, 531-32 (CCPA 1959) ("the reduction to

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skilled in the art is one that clearly supports each positive limitation in the count. *Hyatt v. Boone*, 146 F.3d at 1354-55, 47 USPQ2d at 1130-1132 (Fed. Cir. 1998) (The claim could be read as describing subject matter other than that of the count and thus did not establish that the applicant was in possession of the invention of the count.). See also *Bigham v. Godtfredsen*, 857 F.2d 1415, 1417, 8 USPQ2d 1266, 1268 (Fed. Cir. 1988) ("[t]he generic term halogen comprehends a limited number of species, and ordinarily constitutes a sufficient written description of the common halogen species, except where the halogen species are patentably distinct).

"In an interference proceeding, a party seeking to establish an actual reduction to practice must satisfy a two-prong test: (1) the party constructed an embodiment or performed a process that met every element of the interference count, and (2) the embodiment or process operated for its intended purpose." *Eaton v. Evans*, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000).

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If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985).

For additional cases pertaining to the requirements necessary to establish actual reduction to practice see *DSL Dynamic Sciences, Ltd. v. Union Switch & Signal, Inc.*, 928 F.2d 1122, 1126, 18 USPQ2d 1152, 1155 (Fed. Cir. 1991) ("events occurring after an alleged actual reduction to practice can call into question whether reduction to practice has in fact occurred"); *Corona v. Dovan*, 273 U.S. 692, 1928 C.D. 252 (1928) ("A process is reduced to practice when it is successfully performed. A machine is reduced to practice when it is assembled, adjusted and used. A manufacture [i.e., article of manufacture] is reduced to practice when it is completely manufactured. A composition of matter is reduced to practice when it is completely composed." 1928 C.D. at 262-263 (emphasis added).); *Fitzgerald v. Arbib*, 268 F.2d 763, 765-66, 122 USPQ 530, 531-32 (CCPA 1959) ("the reduction to

practice of a three-dimensional design invention requires the production of an article embodying that design" in "other than a mere drawing").

"The nature of testing which is required to establish a reduction to practice depends on the particular facts of each case, especially the nature of the invention." *Gellert v. Wanberg*, 495 F.2d 779, 783, 181 USPQ 648, 652 (CCPA 1974) ("an invention may be tested sufficiently ... where less than all of the conditions of actual use are duplicated by the tests"); *Wells v. Fremont*, 177 USPQ 22, 24-5 (Bd. Pat. Inter. 1972) ("even where tests are conducted under bench' or laboratory conditions, those conditions must fully duplicate each and every condition of actual use' or if they do not, then the evidence must establish a relationship between the subject matter, the test condition and the intended functional setting of the invention," but it is not required that all the conditions of all actual uses be duplicated, such as rain, snow, mud, dust and submersion in water).

In this case, an actual reduction to practice is alleged to have occurred prior to the earliest effective date of the Dozier reference. However, actual reduction to practice is not fully supported by the documents submitted as evidence.

The Applicants have failed to resolve (at least) the following issues which call into question the actual reduction to practice as alleged in the Applicants' declaration:

- * Paragraph 18 in the declaration states that the website was available by at least May 12, 1995, but Exhibit 4 shows that the domain registration was complete by May 16, 1995.

- * Whether the discussion with Mr. Kennedy prior to 12/21/1994 was about Internet Front Door concept as described in paragraphs 9 - 10 in the declaration.

- * Whether the "source code" in Exhibit 5 was reproducible.

* Whether the "source code" in Exhibit 5 would have resulted in the invention including all of the claim limitations.

* Whether the "Golf USA website" capable of carrying out all of the claimed features existed at least by 05/12/1995

* Whether the "source code" in Exhibit 5 was the final version, or if there were further modifications to the code.

For the reasons cited above, the declarations filed by the Applicants under 37 C.F.R. § 1.131 fail to establish that the claimed invention was reduced to practice prior to the critical period, and also fails to establish that the claimed invention was conceived prior to the critical period and diligently reduced to practice thereafter. As such, the affidavit is insufficient to establish invention prior to the prior art references relied upon in the rejections of record. The rejections are maintained by the examiner.

Claim Objections

The previous claim objections have been withdrawn in light of Applicant's amendments.

However, the present claim objections are made:

Claims 1, 9-10, 12, and 2-21 are objected to because of the following informalities: for consistency in the claims, the Examiner kindly requests Applicant to

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amend all instances of "home page" to be either "home page" (i.e. single word) or "home page" (two words). Appropriate correction is required.

Claims 1 and 12 are objected to because of the following informalities: line 3 of claim 1 and line 4 of claim 12 should state "...an entry..." for grammatical issues. Appropriate correction is required.

Claims 5 and 15, although labeled as amended fail to indicate any such amendments. Therefore the Examiner understands the label of currently amended to be left in this version of claims from the previous version and is disregarded.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title:

Claim 12 rejected under 35 U.S.C. 101 because it intends to claim an apparatus, but does not include hardware or structure to actually define the apparatus to be a machine. Therefore, claim 12 is interpreted as being software (i.e. functional descriptive material) per se and non-statutory subject matter. See MPEP 2106.01. If applicant intends claim 12 to be a machine, there needs to be some form of a structural part of a device or combination of device as part of what is claimed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the mentioning of "said entry" (i.e. lines 6-7 of claim 1 and lines 7-8 of claim 12 is unclear as to which entry in the presenting step it refers to. As the presenting step includes multiple instances of an "entry" (i.e. entry page, user entry, and an entry in an online database) it is unclear what "said entry" refers to.

Claims 3 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically it is unclear if the content includes non-textual information, as it is not specified in the claims.

Claim s 11 and 22 recites the limitation "said account" in the second line. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Compuserve Lets Users Build Own Web Pages, Newsbytes News Network, September 11, 1995 (hereinafter **Compuserve A**) in view of **Dozier et al.** (hereinafter **Dozier**, US 5,870,552) and further in view of **Volpentesta**, A, "A multimedia Bulletin Board in WWW environment", The Second International WWW Conference (WWW'94: Mosaic and the Web, Chicago, Ill, USA, <<http://www.ncsa.uiuc.edu/SDG/IT94/Proceedings/CSCW/volpentesta/giuda.html>>, 4 pages, October 17 - 19, 1994., hereinafter **Volpentesta**).

Compuserve A discloses a method and apparatus for creating a personalized home page with an independent Universal Resource Locator on a web site (See page 2, paragraph 6 "The Publishing Wizard obtains the member's personal URL...") comprising:

receiving said content from said user (See page 2, paragraph 6 "...which will let users 'beam' their completed pages onto the web." If the pages are complete, then the desired content as been entered from said user.);

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creating a unique Transaction ID corresponding to said entry (See page 2, paragraph 6 – USER'SNAME is representative of the Transaction ID);

associating said Transaction ID with said content and said entry (See page 2, paragraph 6 – The URL for the member page includes the Transaction ID, and is considered to be associated with the page);

creating a personalized home page including said desired content (See page 1, paragraph 1 "...enabling them to build design and submit their own home pages on the Internet's World Wide Web" and see paragraph 3, "Also included in The Home Page Wizard is the ability to insert imagines..." This is an example of desired content.);

assigning an independent Universal Resource Locator to said personalized home page, said Universal Resource Locator including said Transaction ID. (See page 2, paragraph 6 "The Publishing Wizard obtains the member's personal URL (uniform resource locator), at <http://compuserve.com/home/USER'SNAME>." The independent URL is necessarily different from the main URL associated with CompuServe, as the URL consists of the username, making it personalized. The Transaction ID is represented by the USER'SNAME. This is essentially what is disclosed in the instant application's specification on page 23, paragraph [0056] "For Example, a URL for a mini homepage might be <http://webwho.com/view?id=xxxx>, where xxxx represents a transaction ID assigned to each entry in a manner described below." The specification gives other examples, but the transaction ID basically represents a unique identifier for the content.)

Compuserve A does not explicitly disclose presenting a entry page to a user for user entry of content into an entry in an online database; and wherein said user interacts creates said personalized homepage using a web browser.

However, **Dozier** discloses presenting a entry page to a user for user entry of content into an entry in an online database; (See column 4, lines 27 – 33 "...A form-driven service is developed by creating a template form comprising one or more informational fields, as well as one or more hypermedia links addressing a database system or other utility program stored on an application server.")

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the references because both are related to creating and publishing web pages, and by including the entry page for entry of content into an online data base as disclosed in **Dozier**, the editing and presentation can be done in a more seamless fashion providing for a more efficient creation of the website (See column 7, line 60). It is for this reason that one of ordinary skill in the art would have been motivated to include presenting a entry page to a user for user entry of content into an entry in an online database.

Additionally, **Volpentesta** discloses and wherein said user interacts creates said personalized homepage [multimedia bulletin] using a web browser. (See Abstract, page 1, 2nd paragraph "In particular, we present a tool which allows a client to realize a multimedia bulletin; text and images are on-line composed by using a front-end WWW page, without requiring any user knowledge about HTML." The web browser would be inherent given that the page is composed on a front-end WWW page. Also see page 2,

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first paragraph "Therefore, the decision was made to implement a kind of interactive system with a page on our server, to which the user is able to connect through whatever WWW browser (e.g. Mosaic).")

It would have been obvious to one with ordinary skill in the art at the time of the invention to combine **Compuserve A** and **Dozier** with **Volpentesta** because all of the references are related to creating and publishing web pages, and by including the web browser teaching as disclosed in **Volepentesta**, the efficiency of the creation of the web page is enhanced because no other software application is needed, as is a goal mentioned in **Dozier**. It is for this reason that one of ordinary skill in the art would have been motivated to include aid user interacts creates said personalized homepage using a web browser.

Claims 2 – 5, 9, 10, 13 – 16, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Compuserve A** in view of **Dozier** and in view of **Volpentesta** as applied to claim 1 above, and further in view of **Compuserve Unveils Web Home Pages** from the Home Office, Communications Week, No. 576, p. 103, September 25, 1995. (hereinafter **Compuserve B**).

Regarding claims 2 and 13, **Compuserve A**, **Dozier**, and **Volpentesta** teach a method substantially as claimed.

Compuserve A, **Dozier**, and **Volpentesta** do not explicitly disclose said content includes user-defined categories of information.

However, **Compuserve B** discloses said content includes user-defined categories of information. (See page 1, paragraph 5, "CompuServe user pages, like those of its rivals, will be cross-indexed and made searchable by topic, name and keyword." It is well known in the art that keywords are generally user-defined categories that represent the information on the page.)

It would have been obvious to one with ordinary skill in the art at the time of the invention to include the category information as disclosed in **CompuServe B** because by doing so, the content is better able to be indexed to allow other users to access it. It is for this reason that one of ordinary skill in the art would have been motivated to include said content includes user-defined categories of information.

Regarding claims 3 and 14, **Compuserve A** additionally discloses non-textual information. (See page 1, paragraph 3 "Also included in The Home Page Wizard is the ability to insert images..." Images are non-textual information, and if they are included on the webpage, presumably they would be related to the content as categorized.)

Regarding claims 4 and 15, **Compuserve A** additionally discloses said non-textual information includes graphics. (See page 1, paragraph 3 "Also included in The Home Page Wizard is the ability to insert images..." Images are also considered graphics.)

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Regarding claims 5 and 16, **Compuserve A**, **Dozier**, and **Volpentesta** teach a method substantially as claimed.

Compuserve A, **Dozier**, and **Volpentesta** do not explicitly disclose said content includes user-defined keywords.

However, **Compuserve B** discloses said content includes user-defined keywords. (See page 1, paragraph 5, CompuServe user pages, like those of its rivals, will be cross-indexed and made searchable by topic, name and keyword." Examiner interprets the keyword here to be user-defined, if the user is allowed to select it.)

It would have been obvious to one with ordinary skill in the art at the time of the invention to include the user-defined keyword information as disclosed in **CompuServe B**, because the content is better able to be indexed to allow other users to access it. It is for this reason that one of ordinary skill in the art would have been motivated to include said content includes user-defined keywords.

Regarding claims 9 and 20, **Compuserve A** discloses said personalized homepage further includes personalized information. (See page 2, paragraph 6 "...also offers the ability for Compuserve members to upload other HTML pages not created by the Home Page Wizard." The other HTML pages are examples of personalized information.)

Regarding claims 10 and 21, **Compuserve A** discloses said personalized information includes a URL to the user's homepage. (See page 2, paragraph 6 "The

Publishing Wizard obtains the member's personal URL (uniform resource locator), at <http://compuserve.com/home/USER'SNAME>." The account is associated with the USER'SNAME, which could be considered personalized information. Here, the user's homepage includes the personalized information.)

Claims 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Compuserve A**, in view of **Dozier**, and in view of **Volpentesta** as applied to claim 1 above, and further in view of BHI offers free hosted Web sites, Interactive Age, volume 2, no 19, page 15, July 17, 1995. (hereinafter **BHI**). **Compuserve A**, **Dozier**, and **Volpentesta** teach a method substantially as claimed. **Compuserve A**, **Dozier**, and **Volpentesta** do not explicitly disclose the act of password-protecting said account. However **BHI** discloses the act of password-protecting said account. (See page 1, paragraph 4, "In the GeoCities scheme, users choose their own street address, register and receive a password to begin building web pages, which can house up to 200 kilobytes of text and graphics each.") It would have been obvious to one with ordinary skill in the art to combine the teachings of the references because they are related to the creation of personalized web pages on the internet and by including the password protection as disclosed in **BHI**, the security of the system is kept intact because only authorized users are allowed to edit the content of the web pages. It is for this reason that one of ordinary skill in the art would have been motivated to include the act of password-protecting said account.

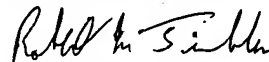
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Timblin whose telephone number is 571-272-5627. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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